

October 14, 2014

The U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Via Email to: TrialsRFC2014@uspto.gov

Thank you for the opportunity to provide comments in response to the *Request for Comments on Trial Proceedings Under the America Invents Act (AIA) Before the Patent Trial and Appeal Board*. These proceedings are of great importance to all intellectual property stakeholders.

As one of the 1,000's of independent inventors the world over who look to our United States Patent Office to provide us with the critically-needed patent and trademark protection for our innovations, I provide these comments in the belief that they are concomitant with the views of a majority of my fellow independent inventors:

1. Claim Construction Standard -- *Under what circumstances, if any, should the Board decline to construe a claim in an unexpired patent in accordance with its broadest reasonable construction?*

For at least the excellent reasons and rationale provided by the Intellectual Property Owner's Association (IPO) in their letter dated 9.16.14 ("letter"), I concur with their response to and recommendations concerning this question.

2. Motion to Amend -- *What modifications, if any, should be made to the Board's practice regarding motions to amend?*

For at least the excellent reasons and rationale provided by the IPO in their letter, excepting the following, I concur with their response to and recommendations concerning this question; including 2(a)(b)(c)(d) and (e).

While in 2(a) the IPO recommends that, "... *a prima facie showing of the substitute claim's validity is the very most a patent owner should be required to provide,*" I would go further in order to align the treatment of amended and new claims with the prosecution approach / patentability analysis to such substitute claims.

The way efforts to amend in trial proceedings are currently treated is akin to a government agency first issuing a building permit to a landowner to build their home, and then – *after the home's been built* – telling the homeowner that the government made a mistake ... that they shouldn't have issued the permit in the first place after all ... or just as bad, telling the homeowner that the permit rules have changed since they received building approval ... and that, since we're not going to let you make any changes to your home to bring it up to today's current building permit requirements, you'll have to either remove or tear down your house.

And furthermore (akin to the current 37 C.F.R. § 42.73(d)(3)), whether you did or didn't attempt to make changes to your home in order to attempt to bring it in compliance with the previous or latest building codes – *something we were never going to let you do even if you had tried (even though we told you that we would consider your request)* -- we also forbid you from building your same home -- or any obvious version of it -- anywhere else, either. Ever.

Oh, and by the way, we're not going to fairly and equitably compensate you for what we took from you.

The government should not be able to discriminate against the holders of intellectual personal property rights by denying them the same legal and constitutional protections and due process rights of real estate and other, non-patent personal property rights.

Yet when it comes to attempting to amend existing and obtaining new claims, isn't that exactly what is occurring in these trials?

Inventors and patent owners should be permitted to amend existing claims and submit new claims in any manner permitted in prosecution before the PTO.

It's the right, legal, and constitutional thing to do.

3. Patent Owner Preliminary Response -- *Should new testimonial evidence be permitted in a Patent Owner Preliminary Response?*

While I understand their reasoning and would otherwise support the IPO's position on this question, because I am concerned about negatively impacting the Office's ability to complete trials in the statutorily-required one year time period by further burdening the Judges, PTAB, and Office, I would here take a different approach than the IPO.

Instead of expanding what evidence the inventor / patent owner is permitted to include in their Preliminary Response, I would for balance, fairness, and equity align and equalize what the petitioner is permitted to include in their petition with what the inventor / patent owner is currently permitted to include in their preliminary response. *Both parties should be treated equally.*

The major problem with arguments for expanding what kinds of information, evidence, etc. should be permitted for the trial institution analysis is the additional time and effort the Judges, PTAB, and Office would have to devote to this early, initial step of the process.

All of this can be (and is being) dealt with in the trials themselves. *Where it all belongs.*

Especially given the very large number of trials which have to date taken place since they have been available, the Judges, PTAB, and Office are well-qualified to make decisions on whether or not to institute trials based on the briefs.

There's no need to pile on yet more pre-trial "stuff" on the backs of the already very busy, hard-working Judges, PTAB, and the Office.

There's no need for a trial ... before the trial.

4. **Obviousness -- *Under what circumstances should the Board permit discovery of evidence of non-obviousness held by the petitioner, for example, evidence of commercial success for a product of the petitioner?***

and

6. **Additional Discovery -- *Are the factors enumerated in the Board's decision in *Garmin v. Cuozzo, IPR2012-00001*, appropriate to consider in deciding whether to grant a request for additional discovery?***

For at least the excellent reasons and rationale provided by the Intellectual IPO in their letter, I concur with their response to and recommendations concerning questions four and six.

5. **Real Party in Interest -- *Should a patent owner be able to raise a challenge regarding a real party in interest at any time during a trial?***

For at least the excellent reasons and rationale provided by the IPO in their letter, I concur with their response to and recommendations concerning this question.

- 7-13. **Multiple proceedings -- *How should multiple proceedings before the USPTO involving the same patent be coordinated?***

For at least the excellent reasons and rationale provided by the IPO in their letter, I concur with their response to and recommendations concerning these questions.

14. **Extension of 1 Year Period to Issue Final Determination -- *What circumstances should constitute a finding of good cause to extend the 1-year period for the Board to issue a final determination in an AIA trial?***

For at least the excellent reasons and rationale provided by the IPO in their letter, I concur with their response to and recommendations concerning this question.

15. **Oral Hearing -- *Under what circumstances, if any, should live testimony be permitted at the oral hearing?***

For at least the excellent reasons and rationale provided by the IPO in their letter, I concur with their response to and recommendations concerning this question.

16. Oral Hearing -- *What changes, if any, should be made to the format of the oral hearing?*

For at least the excellent reasons and rationale provided by the IPO in their letter, I concur with their response to and recommendations concerning this question.

17. General -- *What other changes can and should be made in AIA trials?*

For at least the excellent reasons and rationale provided by the IPO in their letter, I concur with their response to and recommendations concerning this question; including their 17(a), (b), and (c).

Regarding the proposal by Heidi Keefe in her 9.16.14 letter to the Board; including given my reasoning and trial streamlining recommendation in #3, above; I respectfully disagree that AIA petitioners should have the right to file a reply in response to a preliminary patent owner response:

Such a substantive change would allow petitioners to have both the first and last word to the Board on whether or not to institute a trial. Such “boxing in” of the inventor / patent owner in this manner would be both unreasonable and unfair.

Because such a provision would place the petitioner in the enviable, yet clearly inequitable, position of having twice the number of opportunities to make their case as the inventor / patent owner does; in all fairness the only way to reasonably address such a drastic change were it implemented would be by the inventor / patent being allowed to then file a sur-reply to petitioner’s reply in order to both:

1. Address whatever the petitioner allegedly “came up with” in their reply.
2. So as to have the same number of briefs considered by the Board as the petitioner has.

While the submission correctly notes that reply briefs have been a long-standing practice of tribunals in general, AIA trials as envisioned by Congress are a completely new and different kind of animal / tribunal ... set up with a specific, iron-clad speedy time period in which to complete the proceedings. To the best of my knowledge, this tight trial time constraint has never existed before in America.

Accordingly, reply briefs in the context of *these* trials would in fact be *inconsistent* with their goal and purpose.

While the submission contains various “may” statements, “*The patent owner’s Preliminary Response may include ..., and may also include ...*,” “*Petitions may also include*

mischaracterization of the record ...,” and “Petitions may also include arguments not addressed in the petition ...,” [emphasis added] it’s noteworthy that no supporting examples, evidence, or proof is provided in support thereof.

AIA trial proceedings are simply too important to all patent stakeholders to be based on conjecture, supposition, or conclusory statements.

Furthermore, since AIA trials are normally conducted in parallel with ongoing District Court proceedings, very likely in at least the large majority of the cases IPR / CBM petitioners already have much information concerning the contentions, positions, etc. of the inventor / patent owner. They are rarely if ever “flying blind.”

And in any case, let’s remember that we’re talking here about *institution* decisions – which are a long, long way from a final decision. Akin to a preliminary “is there enough here to go forward with a trial?” hearing in criminal cases. Petitioners have plenty of opportunities to make their case during the trial itself. *As they are already doing.*

The Board Judges have a good feel for what is and what isn’t when it comes to institution decisions. A good feel for what matters and what doesn’t. For what makes a case and what doesn’t.

For whether or not to institute a trial.

Smoke and mirrors don’t get far these days at the PTAB.

Again, **there’s no need for a trial ... before the trial.**

Thank you again for this opportunity. I would welcome any further dialog which the Board / Office feels would be helpful to this important process.

/Steve Morsa/

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